

THE PRIORITY DOCUMENT

See the discussion in MPEP § 1893.03(c).

NOTIFICATION OF WITHDRAWAL

If the national stage application papers include an indication that the international application or US designation has been withdrawn, then the application should be brought to the attention of the Office of PCT Legal Administration to determine whether the withdrawal occurred prior to completion of the requirements under 35 U.S.C. 371(c). If the withdrawal occurred prior to completion of the requirements under 35 U.S.C. 371(c), then entry into the U.S. national stage is prohibited. See 35 U.S.C. 366. The indication of withdrawal may appear on a Notification of Withdrawal (PCT/IB/307 or PCT/RO/136), a Notification that International Application Considered to Be Withdrawn (Form PCT/RO/117), or other notification.

1893.03(f) Drawings and PCT Rule 11 [R-2]

The drawings for the national stage application must comply with PCT Rule 11. The copy of the drawings provided by the International Bureau has already been checked and should be in compliance with PCT Rule 11. Accordingly, the drawing provided by the International Bureau (see MPEP § 1893.03(e)) should be acceptable. The USPTO may not impose requirements beyond those imposed by the Patent Cooperation Treaty (e.g., PCT Rule 11). However, the examiner does not have the authority to require new drawings if the drawings were published without meeting all requirements under the PCT for drawings.

1893.03(g) Information Disclosure Statement in a National Stage Application [R-3]

An extensive discussion of Information Disclosure Statement practice is to be found in MPEP § 609. Although not specifically stated therein, the duty to disclose information material to patentability as defined in 37 CFR 1.56 is placed on individuals associated with the filing and prosecution of a national

stage application in the same manner as for a domestic national application. The averment with respect to the duty under 37 CFR 1.56 required under 37 CFR 1.63(b)(3) in an oath or declaration is applicable to oaths and declarations filed in U.S. national stage applications. See 37 CFR 1.497(c).

When an international application is filed under the Patent Cooperation Treaty (PCT), prior art documents may be cited by the examiner in the international search report and/or the international preliminary examination report. It is desirable for the U.S. examiner to consider the documents cited in the international application when examining the U.S. national stage application or when examining an application filed under 35 U.S.C. 111(a) which claims the benefit of the international application under 35 U.S.C. 365(a) or (c).

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When all the requirements for a national stage application have been completed, applicant is notified (Form PCT/DO/EO/903) of the acceptance of the application under 35 U.S.C. 371, including an itemized list of the items received. The itemized list includes an indication of whether a copy of the international search report and copies of the references cited therein are present in the national stage file. The examiner will consider the documents cited in the international search report, without any further action by applicant under 37 CFR 1.97 and 1.98, when both the international search report and copies of the documents are indicated to be present in the national stage file. The examiner will note the consideration in the first Office action. There is no requirement that the examiners list the documents on a PTO-892 form. See form paragraphs 6.53, 6.54, and 6.55 (reproduced in MPEP § 609.03). Otherwise, applicant must follow the procedure set forth in 37 CFR 1.97 and 1.98 in order to ensure that the examiner considers the documents cited in the international search report.

This practice applies only to documents cited in the international search report relative to a national stage application filed under 35 U.S.C. 371. It does not apply to documents cited in an international preliminary examination report that are not cited in the search report. It does not apply to applications filed under 35 U.S.C. 111(a) claiming the benefit of an international application filing date.